

Remarks

In response to the Office Action dated October 5, 2005, Applicant respectfully requests reconsideration based on the following remarks. Applicant respectfully submits that the claims as filed are in condition for allowance.

Claim Rejections Under 35 U.S.C. §102(b)

Claims 1, 2, 6, 7, and 9-30 have been rejected under 35 U.S.C. §102(b) as being anticipated by Bennett et al. U.S. Patent No. 4,226,071 hereinafter referred to as Bennett. The Examiner states:

"Bennett shows a roof system comprising...a waterproof membrane loose laid over the energy absorbing layer..."

Applicant respectfully asserts that the built up roof designated by the Examiner as the "waterproof membrane" in Bennett is not "loose laid" over what the Examiner designates as the "energy absorbing layer." Instead, referring to column 4 lines 10-13 of the Bennett disclosure, "the built up roof comprises a plurality of layers bonded together *and to the layer* with asphalt," wherein the Examiner asserts that the "*layer*" is the energy absorbing layer. This bonded association between that which the Examiner asserts is the waterproof membrane and that which the Examiner asserts is the energy absorbing layer is the only manner or mention of association disclosed by Bennett, and bonding in this manner would prevent Bennett's membrane from moving independently of what is designated as the energy absorbing layer.

On the contrary, Applicant's membrane is loose laid over the energy absorbing layer so it will be functionally allowed to move independently of the energy absorbing layer and be "pulled by object (such as a hail stone) into a depression created thereby preventing rupture of membrane." Thus, Bennett's bonding is not only in opposition to the plain meaning of Applicant's phrase "loose laid," but is also in opposition to the functionality of the loose laying (independent movement), which allows the membrane to be drawn by the impacting object itself into an impacted area of the energy absorbing layer. In fact, if the Applicant's waterproof membrane was bonded to the energy absorbing layer as is suggested by Bennett, Applicant's

membrane would be incapable of the benefit of membrane depression. Thus, since Bennett does not teach a loose laying of the waterproof membrane, it does not teach each and every element of independent Claims 1, 17, and 18. Furthermore, since Claims 2, 6, 7, 9-16 and 22-30 depend from Claim 1, and since Claims 19-21 depend from Claim 18, Bennett does not teach each and every element of these dependant Claims either. Referring more particularly to some of the dependant claims, Bennett does not teach a membrane that is air sealed to a wall as stated by Claims 10 and 23, nor does it teach the membrane wrinkle of Claims 11-16 and 24-29. Thus Bennett additionally fails to teach elements particular to these dependent claims.

It should be additionally noted, referring again to column 4 lines 9-13, that Bennett's "built up roof", includes a layer (69 in Bennett Fig 4) that the Examiner equates to the "energy absorbing layer" ("The built up roof *comprises* a plurality of roofing felt bonded together and to the *layer 69*"). If, as mentioned above, the Examiner asserts that the built up roof IS the waterproof membrane, and this waterproof membrane includes the layer 69, then that layer 69 is taught by Bennett only as a waterproofing layer, NOT an "energy absorbing layer." Thus, Bennett would be without the "energy absorbing layer," and fail to teach another element of Applicant's Claims.

Claim Rejections Under 35 U.S.C. §103(a)

Claims 3 and 8 (though in detailed item 6, the Examiner mistakenly refers to Claim 8 as Claims 4 and 5) have been rejected under 35 U.S.C. §103(a) as being unpatentable over Bennett, and Claims 4 and 5 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Bennett in view of Nurley et al. U.S. Patent No. 6,250,036 hereinafter referred to as Nurley. However, as mentioned above, Bennett does not suggest or teach a "loose laid" waterproof membrane, and in fact teaches away from a loose laying of the membrane by teaching bonding. Nurley also does not teach a loose laying of the membrane, and thus, "a waterproof membrane loose laid over the energy absorbing layer," is an element included in Claims 3-5 that is not taught by the references.

All of the rejections are herein overcome. No new matter is added by way of the present Remarks, as support is found throughout the original filed specification, claims, and drawings. Notice of Allowance is respectfully requested.

If the Examiner has any questions regarding the instantly submitted response, Applicant's attorney respectfully requests the courtesy of a telephone conference to discuss any matters in need of attention.

If there are any additional charges with respect to this response or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' attorney.

Respectfully submitted,

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By: 

Date: December 22, 2005

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